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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,091	10/01/2001	Massimo Grasso	IR-1951 (2-2472)	4728

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EXAMINER

CUNNINGHAM, TERRY D

ART UNIT PAPER NUMBER

2816

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/966,091

Applicant(s)

GRASSO ET AL.

Examiner

Terry D. Cunningham

Art Unit

2816

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2816

## DETAILED ACTION

### *Drawings*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 27 January 2003, has been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. Driver 44 is deemed critical or essential to the practice of the invention, but is not included in the claim(s). An arrangement lacking this feature is not enabled by the disclosure since it cannot be understood from the specification how the circuit will operate without such. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Examiner has not found the amendment to the claims to overcome the above rejection. At most, the new language concerning the “driver” can only be deemed to be “intended use”. Since an “intended use” recitation would not be considered to be a positive recitation of structure, the above rejection is hereby maintained.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2816

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 1-2, the language therein is not understood. It is not understood how the “power control circuit” can “control power”, when such requires another element separate therefrom, i.e., the “driving circuit”. Additionally, there is no support in the specification for the “driving circuit” being separate from the “power control circuit”, as now recited. The “power control circuit” is disclosed as being, for example, the entire circuit shown in Fig. 4, which clearly includes the “driver” as part thereof. Addition, it is not understood how the circuit can control “power” when there has been no means recited to control the “power device” nor has there been an input recited. In lines 6-7, it is not understood how the circuit can have the recited operation when there has been nothing recited to operate the “power device”.

Claims 2-8 and 18 are rejected for the reasons discussed above with claim 1.

Examiner has fully considered Applicant’s remarks for the above rejection and has not found them to be persuasive. It is not understood how the amendment can have any affect on the outstanding rejection. All of the elements in Fig. 4 are the “power control circuit”, not just the few elements recited. In view of the disclosure, the recited elements are only for controlling the “power device”. The recited structure, separate from the “power device”, would not be seen to be a “power control circuit”.

In claim 20, lines 2-4, a high side driving circuit” has already been recited in claim 17. Also, it is not understood how the “high side circuit” can control a “high side driving circuit” (as recited in claim 1) when it includes a “high side driving circuit”. Also, in lines 5-7, the language

Art Unit: 2816

concerning the “low side driving circuit” is indefinite for similar reasons as discussed in lines 2-4.

Claims 9-17 and 19-22 are rejected for similar reasons as discussed above with claims 1-8 and 18.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. §102(b) as being anticipated by Kimura et al. (USPN 5,210,479). Kimura et al. discloses, in Fig. 1, a circuit comprising: “a driving circuit (7,8)”; “a power device (10)”; “sensing circuitry (14 and 20)”; “a gating device (12)”; and “correction circuitry (remainder of circuit)”, all connected and operating similarly as recited by Applicant.

Examiner has fully considered Applicant’s remarks for the above rejection and has not found them to be persuasive. Clearly, the “overcurrent” discussed in the reference to Kimura et al. would reasonably be considered to be “spurious information”. Reference is made to Col. 5, line 59, through Col. 6, line 12, which expressly recites the operation of the “correction circuitry”. This section expressly states how the circuit prevents the spurious information from being passed to the “gating device”.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2816

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry Cunningham whose telephone number is 703-308-4872. The examiner can normally be reached on Monday-Thursday from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan can be reached on 703-308-4876. The fax phone numbers for Technology Center 2800 are 703-872-9318 for Before Final communications and 703-872-9319 for After Final communications. Please note, any faxed paper clearly stating **DRAFT** or **PROPOSED AMENDMENT** at the top will be forwarded directly to the Examiner. All others will be treated as a formal response and acted upon accordingly.

Art Unit: 2816

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0956.

TC  
March 3, 2003

  
Terry D. Cunningham  
Primary Examiner  
Art Unit 2816